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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			FERGUSON, KEITH	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,554

Applicant(s)

HOSPES, GERD-JOACHIM

Examiner

Keith T. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-33 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18, 20, 21 and 23-29 is/are rejected.
- 7) ☒ Claim(s) 10, 19 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 112

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Step E and Step F.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,3,4,7-9,14,20,21,23-25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hosain.

The claimed invention reads on Hosain as follows:

Regarding claims 1,3,7,8,9,14 and 20, Hosain discloses a cellular phone (title, fig. 3 and col. 20 lines 1-6) (mobile communication terminal) for use in a wireless communication network (title, and fig. 1 number 130), the mobile communication terminal comprising: a memory containing a disable command (first switch-off code) of the mobile communication terminal (col. 13 lines 39-66 and col. 21 lines 27-44), a processor unit controlling the status of the mobile terminal (col. 21 lines 27-44), said mobile terminal being adapted for receiving a remote switch-off signal containing a disable command (second switch-off code) via the communication network (col. 13 lines 39-66 and col. 21 lines 27-44), and the processor unit being adapted for switching off the terminal when the first switch-off code stored in the memory and the second switch-off code contained in the switch-off signal are identical (i.e. disable codes are compared

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to disable codes within the cellular phone memory which disables the cellular phone (title and col. 21 lines 27-44).

Regarding claims 4 and 28, Hosain discloses a Mobile Identification number (MIN) (i.e. a response telephone number) (col. 13 lines 42-47).

Regarding claims 21 and 23, Hosain discloses a method (col. 23 line 32 through col. 24 line 34) for remotely switching off a cellular phone (first mobile communication terminal) having a given mobile identification number (MIN) subscriber identity associated therewith (title, col. 13 lines 42-67 and col. 23 line 32 through col. 24 line 34), comprising the steps of: (A) sending a disable instruction (remote switch-off signal) via a cellular wireless communication network to the first mobile communication terminal (col. 23 line 32 through col. 24 line 34), (B) receiving the remote switch-off signal on the first mobile communication terminal (col. 23 line 32 through col. 24 line 34), (C) verifying the remote switch-off signal on the first mobile communication terminal (col. 23 line 32 through col. 24 line 34), and (D) if the verification in step (C) is positive then switching off the first mobile communication terminal (col. 23 line 32 through col. 24 line 34).

Regarding claim 24, Hosain discloses a parameter for identifying it as a remote switch-off signal, and a second switch-off code (col. 13 lines 42-67 and col. 23 line 32 through col. 24 line 34).

Regarding claim 25, Hosain discloses recognizing said parameter for identifying a remote switch-off signal (col. 13 lines 42-67 and col. 23 line 32 through col. 24 line 34), and comparing a first switch-off code stored in a memory of the first mobile communication terminal and the second switch-off code contained in the remote switch-off signal (col. 21 lines 29-44).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Trommelen.

Regarding claim 2, Hosain discloses a cellular phone as discussed supra in claim 1 above. Hosain differs from claim 2 of the present invention in that it does not disclose receiving a switch off signal from an owner of the mobile communication terminal. Trommelen teaches a remote electronic device that can receive a shutdown command from a subscriber (owner) (col. 4 line 55 through col. 5 line 13 and fig. 3 number 322). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hosain with receiving a switch off signal from an owner of the mobile communication terminal in order for the cellular phone to be disable when the owner notifies the cellular phone factory that the phone is lost, as taught by Trommelen.

Regarding claim 11, Hosain discloses the control module comprises a disable module (terminal switch-off module), which runs a disable process (switch-off process) col. 21 lines 27-44).

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9. Claims 5,6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Morrison et al..

Regarding claim 5 and 6, Hosain discloses a cellular phone as discussed supra in claims 1 and 3 above. Hosain differs from claims 5 and 6 of the present invention in that it does not disclose a response email address and a word, such as "PHONEOFF". Morrison et al. teaches a wireless communication for activating a restrictive function from a response email or email address and password (p:0016 lines 1-21 and p:0046 lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with a response email address and a word, such as "PHONEOFF" in order for the cellular phone to be disable based upon a text mail message or password, as taught by Morrison et al..

Regarding claim 29, Hosain discloses a method as discussed supra in claim 21 above. Hosain differs from claim 29 of the present invention in that it does not disclose a response email address. Morrison et al. teaches a wireless communication for activating a restrictive function from a response email or email address (p:0016 lines 1-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with a response email address in order for the cellular phone to be disable based upon a text mail message, as taught by Morrison et al..

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Trommelen as applied to claims 1 and 2 above and in further view of Lee et al..

Regarding claims 12, the combination of Hosain and Trommelen differs from claims 12 of the present invention in that they do not disclose a non-switch-off confirmation message signal to the owner if an error occurs. Lee et al. teaches mobile terminal sends non permitted message to the network (col. 6 lines 1-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hosain and Trommelen with a non-switch-off confirmation message signal to the owner if an error occurs in order for cellular phone to notify the cellular phone factory to be delivered to the owner of the cellular phone that the phone disable message is in error, as taught by Lee et al..

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Regarding claim 13, the combination of Hosain and Lee et al. differs from claim 12 of the present invention in that they do not disclose a terminal EOTD location. Trommelen teaches a remote communication device determines its location and sends its location to a network for a subscriber (col. 3 lines 63 through col. 4 lines 15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hosain and Lee et al. with a terminal EOTD location in order for the disable cellular phone to send its location to the cellular phone factory before disabling the terminal, as taught by Trommelen.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Jung.

Regarding claim 15, Hosain discloses a cellular phone as discussed supra in claim 1 above. Hosain differs from claim 15 of the present invention in that it does not disclose a display module for displaying a terminal switch-off message. Jung teaches a mobile communication terminal which displays a remote warning message for powering off command (P:0041 lines 1-4 and P:0052 lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with a display module for displaying a terminal switch-off message in order for the cellular phone to notify someone that the cellular phone is disable before they try to use it, as taught by Jung.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Helle.

Regarding claim 16, Hosain discloses a cellular phone as discussed supra in claim 1 above. Hosain differs from claim 16 of the present invention in that it does not disclose a message in Short Messaging System (SMS) format. Helle teaches a mobile phone for receiving a remote short message system message to restrict access to the mobile phone (abstract and col. 1 lines 40-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with a message in Short Messaging System (SMS)

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format in order for the cellular phone to disable its functions by a text message, as taught by Helle.

13. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Ratert et al..

Regarding claims 17 and 18, Hosain discloses a a cellular phone as discussed supra in claim 1 above. Hosain differs from claims 17 and 18 of the present invention in that it does not disclose a SIM card containing a subscriber identity and the subscriber identity contained in the SIM card is the same subscriber identity contained in at least another SIM card. Ratert et al. teaches a cellular device that comprises a SIM card containing a subscriber identity (abstract lines 1-4 and P:0016 lines 1-14) and is the same subscriber identity contained in at least another SIM card (P:0016 lines 1 through P:0017 line 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hosain with a SIM card containing a subscriber identity and the subscriber identity contained in the SIM card is the same subscriber identity contained in at least another SIM card in order for the cellular phone to be able to communicate with a cellular communication network and for the cellular phone to share its communication services from it SIM card with another telephone such as a car phone, as taught by Ratert et al..

14. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosain in view of Lee et al..

Regarding claim 26, Hosain discloses a method as discussed supra in claim 21 above. Hosain differs from claim 26 of the present invention in that it does not disclose sending a switch-off confirmation message signal before the terminal switches completely off. Lee et al. teaches a portable device that sends a confirmation message if the request is permitted (col. 6 lines 60-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with sending a switch-off confirmation message signal before the terminal switches completely off in order for the cellular phone to send a message to the factory that the disable signal was received successful before shutting down, as taught by Lee et al..

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Regarding claim 27, Hosain discloses a method as discussed supra in claim 21 above. Hosain differs from claim 26 of the present invention in that it does not disclose sending a non-switch-off confirmation message signal. Lee et al. teaches a portable device that sends a confirmation message that a request signal is not permitted (col. 6 lines 60-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hosain with sending a non-switch-off confirmation message signal in order for the cellular phone to notify the cell phone factory that the disable signal is not properly received and to resend the disable signal to disable the cellular phone, as taught by Lee et al..

Allowable Subject Matter

15. Claims 10,19 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 10, the prior art of record fails to teach or suggest, alone or in combination wherein the remote message signal verification module deletes the first switch-off code stored in the memory of the terminal after a predetermined number of consecutive remote switch-off signals having a second switch-off code different from the first switch-off code.

Regarding claim 19, the prior art of record fails to teach or suggest, alone or in combination wherein the processor switches off the terminal only if the remote switch-off signal is triggered by a second mobile communication terminal having a SIM card with the same subscriber identity.

Regarding claim 22, the prior art of record fails to teach or suggest, alone or in combination a step (E) before step (A) comprising switching off a second mobile communication terminal having associated therewith the same subscriber identity as the

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first mobile communication terminal, and a step (F) after step (D) comprising switching on the second mobile communication terminal, and wherein in step (A) the remote switch-off signal is sent from a third mobile communication terminal having associated therewith a subscriber identity different from that of the first and the second mobile communication terminals.

17. Claims 30-33 are allowed.

18. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 30, the prior art of record fails to teach or suggest, alone or in combination calling a predetermined telephone number of a wireless communication network provider from a second mobile communication terminal having associated if the network provider verifies that the first mobile communication terminal is switched on, therewith the same subscriber identity that said first mobile communication terminal, cause said network provider to verify if the first mobile communication terminal is switched on, causing said network provider to send a remote switch-off signal to the first mobile communication terminal, and switching off the first mobile communication terminal upon receipt of the remote switch-off signal.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayashi Tsutomu (JP 111777682) discloses a radio communication equipment that remotely shut down a SIM card for a distant telephone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (571) 272-7865. The examiner can normally be reached on 6:30am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith Ferguson
Art Unit 2617
May 25, 2006

KEITH FERGUSON
PRIMARY EXAMINER
